

Remarks

Claims 1-6 are presently pending. **Claims 1-6 have been rejected.**

The Examiner has objected to claims 5 and 6 because of informalities. Claims 5 and 6 have been amended to incorporate all of the changes required by the Examiner. All of these amendments are purely formal. Hence, no new matter has been added.

Reconsideration and withdrawal of the objection are respectfully requested. Please remove the objection to claims 5 and 6, and enter the allowance thereof.

The Examiner has objected to claims 1-6 because of an informality. Claim 1 has been amended to incorporate the change required by the Examiner. This amendment is purely formal. Hence, no new matter has been added.

Reconsideration and withdrawal of the objection are respectfully requested. Please remove the objection to claims 1-6, and enter the allowance thereof.

The Examiner has rejected claims 1, 2, 4-6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,221,118 to Chicckine ("Chicckine") in view of U.S. Patent

No. 4,497,186 to Mason ("Mason"). The Examiner asserts that Chicckine teaches all of the limitations of the secure interchangeable earring recited in claim 1 except that the middle portion between the apex portion and the free end is spiraling. However, the Examiner contends that Mason discloses an earring with an apex and a spiraling section for additional decoration in the figures, especially Figures 2 and 8. The Examiner concludes that it would have been obvious to one of ordinary skill in the art, having the teachings of Chicckine and Mason before him at the time the invention was made, to modify Chicckine as taught by Mason to include the decorative spiral of Mason in order to obtain a more decorative and versatile earring, since Mason discloses that it is an advantage to have part of the attachment portion also serve as a decorative feature. The Examiner maintains that Chicckine also teaches the limitations recited in claims 2 and 4. With regard to claims 5 and 6, the Examiner asserts that the method of use is intrinsically taught by the apparatus since no other method would result in the arrangement shown in Figure 2 and the method is discussed in Chicckine.

This rejection is respectfully but strenuously traversed for the reasons set forth in detail below.

In general, three basic criteria must be satisfied in order to establish a prima facie case of obviousness

(M.P.E.P. § 706.02(j)). First, the reference or combination of references must teach or suggest all of the claim limitations. Second, there must be a reasonable expectation of success. Third, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The rejection fails to satisfy the third criterion of a prima facie showing of obviousness. One of ordinary skill in the art would have no motivation to combine the teachings of Chicckine and Mason in the manner relied upon by the Examiner. Chicckine provides no indication that the middle portion of the rod 1 can be so modified:

It will be appreciated that various modifications may be made to the curvature and length of the outer and inner portions 4 and 8 of the holder without departing from the spirit of the invention. It is readily apparent that the holder, in use, is approximately balanced in the ear lobe 9 of the user, being configured so the outer portion 4 is smaller than the inner portion 8 and so as to provide that the interior arm 10 of the inner portion 8 performs as a counterbalance to the outer portion 4 and the earring 5.

(col. 2, lines 26-35) Thus, Chicckine teaches that only the length and curvature of the inner portion 8 can be altered. Chicckine does not suggest that the basic configuration of the interior arm 10 of the inner portion 8 can be changed at all, much less in a fundamental way to assume the spiraling

shape described in Mason. In addition, the teaching of Chicckine that the rod 1 should be approximately balanced in the ear lobe 9 counsels against such an alteration. If the interior arm 10 was redesigned to the spiral of Mason, it would not counterbalance the outer portion 4 and the earring 5 as required by Chicckine. It is important to note that the secure interchangeable earring of claim 1 is decidedly unbalanced.

Furthermore, a skilled artisan would not gain the necessary motivation to combine teachings from Mason. The sole indication to the contrary cited by the Examiner must be more closely scrutinized and more clearly understood. Mason states:

Accordingly, it is among the objects of the invention to provide a simple yet very attractive earring which is unusual in appearance and which has a decorative portion which also serves as at least a part of the attachment device for the earring.

(col. 1, lines 60-64) Thus, by its own terms, this language indicates only that it is advantageous to provide the earring with a decorative portion that also functions as a means of attaching it to the ear of the user. This general proposition can be accorded with, and its efficacy affirmed, in the design of a wide range of earrings. Mason fails to describe any benefit that is uniquely associated with earrings having a spiraling middle portion extending between

an apex portion and a free end, as recited in claim 1. There are other equally decorative portions of earrings that users can employ for attachment to their ears. Indeed, some consumers might prefer one of these alternative components, including the interior arm 10 of Chicckine, for any of a wide variety of reasons. For these reasons, the combined disclosure of Chicckine and Mason does not render obvious the secure interchangeable earring of claim 1. Consequently, the combination of Chicckine and Mason cannot render obvious the method of claim 5 which also uses an earring with a spiraling middle portion located between an apex portion and a free end. Claims 2 and 4 depend directly from claim 1 and therefore contain all of its limitations. Claim 6 depends directly from claim 5 and therefore contains all of its limitations. Thus, claims 1, 2, 4-6 are patentably distinct from the cited combination of references.

Reconsideration and withdrawal of the rejection are respectfully requested. Please remove the rejection of claims 1, 2, 4-6 under 35 U.S.C. § 103(a), and enter the allowance thereof.

The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Chicckine in view of Mason, and further in view of U.S. Patent No. Des. 175,867 to Sutain ("Sutain"). The Examiner acknowledges that Chicckine in view of Mason does not disclose a plurality of concentric circles

at the blocked end which do not allow the charm to pass that portion of the body. The Examiner notes that Chicckine specifically teaches that the shape of the enlarged head can vary as long as it is aesthetically pleasing. The Examiner contends that Sustain discloses an earring with a decorative end comprising the wire body bent to form concentric circles which would not allow a charm to pass. The Examiner concludes that it would have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made to change the design of the blocked end since the Applicant has not disclosed that concentric circles versus a ball end solves any stated problem or is for any particular purpose and it appears that the invention would function equally well with the ball end.

This rejection is respectfully but strenuously traversed for the reasons set forth in detail below.

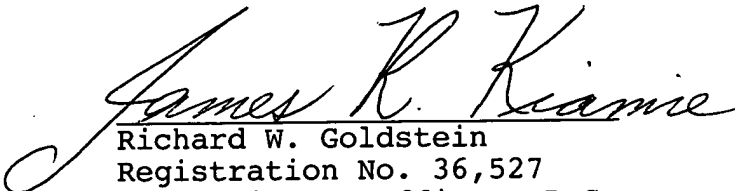
The rejection fails to satisfy the third criterion of a prima facie showing of obviousness. As discussed, previously, one of ordinary skill in the art would have no motivation to combine the teachings of Chicckine and Mason in the manner relied upon by the Examiner. The addition of Sustain, which relates to a jewelry finding, to the combination of Chicckine and Mason fails to cure this deficiency. Hence, the combined disclosure of Chicckine, Mason and Sustain does not render obvious the secure

interchangeable earring of claim 1. Claim 3 depends directly from claim 1 and therefore contains all of its limitations. Consequently, claim 3 is patentably distinct from the cited combination of references.

Reconsideration and withdrawal of the rejection are respectfully requested. Please remove the rejection of claim 3 under 35 U.S.C. § 103(a), and enter the allowance thereof.

In view of the foregoing amendments and remarks, reconsideration and allowance of the pending claims are respectfully solicited. Please remove the objection to claims 5 and 6, the objection to claims 1-6, the rejection of claims 1, 2, 4-6 under 35 U.S.C. § 103(a) and the rejection of claim 3 under 35 U.S.C. § 103(a), and enter the allowance of pending claims 1-6. The Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted, *Reg. No. 53,120*

 *James R. Kiamie* for  
Richard W. Goldstein  
Registration No. 36,527  
Goldstein Law Offices, P.C.  
Attorneys for Applicant  
2071 Clove Road  
Staten Island, NY 10304  
(718) 727-9780

RWG/JRK/jrk